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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.           | CONFIRMATION NO. |
|---|-------------|----------------------|-------------------------------|------------------|
| 10/080,622  | 02/25/2002  | Koichi Takahashi     | 1448.1021                     | 8100             |
| 21171   | 7590        | 11/04/2005           |                               |                  |
| STAAS & HALSEY LLP<br>SUITE 700<br>1201 NEW YORK AVENUE, N.W.<br>WASHINGTON, DC 20005 |             |                      | EXAMINER<br>DENNISON, JERRY B |                  |
|   |             |                      | ART UNIT                      | PAPER NUMBER     |
|   |             |                      | 2143                          |                  |

DATE MAILED: 11/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/080,622

Applicant(s)

TAKAHASHI, KOICHI

Examiner

J. Bret Dennison

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 05 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This Action is in response to Amendment for Application Number 10/080,622 received on 05 August 2005.
2. Claims 1-9 are presented for examination.

### ***Claim Interpretation***

3. Before a detailed mapping, a brief interpretation of the amended claimed invention should be made to clarify how Examiner is interpreting the claims. The claimed invention has been amended to include sending a reception refusal "to the same transmitter" a particular number of times, the changes significantly narrowing the scope of the claims. The phrase "a particular number of times" can be taken as broadly as "zero times" or "one time". There is no limit on the phrase and therefore will have very little patentable weight. The term, "recipient", as used throughout the claimed invention can be interpreted as a device that receives whatever data is being transmitted, in terms of the claimed invention, electronic mail. Examiner is required to interpret the claims to their broadest reasonable interpretation, see MPEP 2111.

### ***Claim Objections***

Claim 4 is objected to because of the following informalities: Claim 4 includes a typo with two commas, " , , ". Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-8 are rejected under 35 U.S.C. 102(e) as being anticipated by Pace et al. (U.S. Patent Number 6,460,050).

4. Regarding claims 1 and 6-9, Pace discloses a method and apparatus for preventing transmission of junk mail, comprising:

relaying electronic mail from a transmitter to a recipient (Pace, see Figure 2, Tier System 20 sending the message to Tier System 30, which is the recipient in this case);

sending a warning notice to the transmitter, when the recipient determines that the received electronic mail is junk mail and sends a reception refusal notice (Pace, col. 3, lines 45-50, Pace disclosed the Second Tier System determining if the email is spam, and based on the determination is made, a reply is send to the first tier system, which is the transmitter); and

issuing a penalty invoice notice to the transmitter, when the recipient sends the reception refusal notice to the same transmitter a particular number of times (Pace, col. 4, lines 40-53, Pace disclosed that revenue may be generated based on volume or other revenue criteria, meaning based on the amount of times the second tier system was used to determine if the email was spam).

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Claims 6-9 include limitations that are substantially similar to claim 1 and are therefore rejected under the same art as claim 1 as being substantially similar.

5. Regarding claim 2, Pace discloses the limitations, substantially as claimed, as described in claim 1, including processing a penalty fee, collected from the transmitter feeding back the penalty fee to the recipient (Pace, col. 4, lines 40-53, Pace does not specifically state processing a penalty fee collected from the transmitter. However it is inherent that the fee is collected from the First Tier System to the Second Tier System in order for the system as a whole to properly function).

6. Regarding claim 3, Pace discloses the limitations, substantially as claimed, as described in claim 2, including wherein an amount equal to the penalty fee owed to the recipient is deducted from the charges the recipient is required to pay for maintaining an electronic mail account (Pace, col. 4, lines 40-53, Pace does not explicitly state deducting from charges, however it is inherent that it costs money for the Second Tier System to properly run and receive email, and produce notifications).

7. Regarding claim 4, Pace discloses the limitations, substantially as claimed, as described in claim 1, including wherein in response to sending the reception refusal notice to the same transmitter another particular number of times, stopping relaying of electronic mail from the transmitter to the recipient (Pace, col. 4, lines 40-53).

8. Regarding claim 5, Pace discloses the limitations, substantially as claimed, as described in claim 1, including wherein the warning notice is sent after the recipient sends the reception refusal notice a first time, and the penalty invoice notice is issued when the particular number of times is equal to two (Pace, col. 4, lines 40-53, Pace did not explicitly state wherein the particular number of times is equal to two, however, the fee is based on volume which can include any set size).

### **Response to Amendment**

Applicant's arguments and amendments filed on 08/05/2005 have been carefully considered but they are not deemed fully persuasive. Applicant's arguments are deemed moot in view of the following new grounds of rejection as explained here below, necessitated by Applicant's substantial amendment (*i.e., by incorporating new limitations into the independent claims, which will require further search and consideration*) to the claims which significantly affected the scope thereof.

Applicant does not provide any arguments, but rather just points out what the prior art reference disclosed and what the instant application teaches. Applicant should submit arguments, pointing out disagreements with the examiner's contentions. Applicant must also discuss the references applied against the claims, explaining how the claims avoid the references or distinguish from them. Simply stating what the claimed invention teaches and what the references disclosed does not provide explanation as to how the claimed invention distinguishes over the prior art rejections.

Applicant states that Pace et al. taught, "revenue may be generated... by providing a filtering service for a fee ***based on volume or other revenue criteria*** [Emphasis added by Applicant]".

Applicant states that the instant application teaches, "issuing a penalty invoice notice ***to the transmitter*** [Emphasis added by Applicant]" when the recipient sends the reception refusal notice to the same transmitter a particular number of times, [see Applicant's Response, page 6].

Examiner interprets the Second Tier System (Fig. 2, **30**) to be the recipient, and the First Tier System (Fig. 2, **20**) to be the transmitter. The Second Tier System generates revenue by requiring a fee based on volume, which means the First Tier System pays a fee based on the volume of use of the Second Tier System as shown in the above cited mapping (Pace, col. 4, lines 40-53), which includes the number of times the Second Tier System sends the refusal notices.

It is evident from the mappings found in the above rejection that Pace disclosed the teaching of "issuing a fee". Further, it is clear from the numerous teachings (previously and currently cited) that "issuing an invoice" was widely implemented in the networking art.

Thus, Applicant's arguments drawn toward distinction of the claimed invention and the prior art teachings on this point are not considered persuasive. It is also clear to the Examiner that Pace clearly disclosed the independent claims of the Applicant's claimed invention.

Applicant's arguments with respect to claims 1-9 are deemed moot in view of the following new grounds of rejection, necessitated by Applicant's amendment to the claims, which significantly affected the scope thereof.

Furthermore, as it is Applicant's right to continue to claim as broadly as possible their invention, it is also the Examiner's right to continue to interpret the claim language as broadly as possible. It is the Examiner's position that the detailed functionality that allows for Applicant's invention to overcome the prior art used in the rejection, fails to differentiate in detail how these features are unique. As it is extremely well known in the networking art as already shown by Pace as well as other prior arts of records disclosed, "requiring payment for spam determination" is taught as well as other claimed features of Applicant's invention. By the rejection above, the applicant must submit amendments to the claims in order to distinguish over the prior art use in the rejection that discloses different features of Applicant's claimed invention.

It is the Examiner's position that Applicant has not yet submitted claims drawn to limitations, which define the operation and apparatus of Applicant's disclosed invention in manner, which distinguishes over the prior art.

Failure for Applicant to significantly narrow definition/scope of the claims and supply arguments commensurate in scope with the claims implies the Applicant intends broad interpretation be given to the claims. The Examiner has interpreted the claims with scope parallel to the Applicant in the response and reiterates the need for the Applicant to more clearly and distinctly define the claimed invention.



### ***Conclusion***

**Examiner's Note:** Examiner has cited particular columns and line numbers in the references applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

In the case of amending the claimed invention, Applicant is respectfully requested to indicate the portion(s) of the specification which dictate(s) the structure relied on for proper interpretation and also to verify and ascertain the metes and bounds of the claimed invention.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of


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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

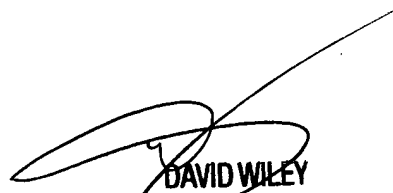
Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. Bret Dennison whose telephone number is (571) 272-3910. The examiner can normally be reached on M-F 8:30am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A Wiley can be reached on (571) 272-3923. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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